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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,309	08/28/2003	Michael W. Wathen	Pharmacia Case 01668	9026
26303	7590	12/05/2005	EXAMINER	
FLYNN, THIEL, BOUTELL & TANIS, P.C.			ROYDS, LESLIE A	
2026 RAMBLING ROAD			ART UNIT	
KALAMAZOO, MI 49008-1631			PAPER NUMBER	

1614

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/651,309	Applicant(s) WATHEN ET AL.	
	Examiner Leslie A. Royds	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

**Claims 1-58 are presented for examination.**

#### ***Requirement for Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2-6, drawn to a method of preventing or treating atherosclerosis or restenosis using a compound of formula (I), classified in class 514, subclass 312.
- II. Claims 7-11, drawn to a method of preventing or treating atherosclerosis or restenosis using a compound of formula (II), classified in class 514, subclass 312.
- III. Claims 12-30, drawn to a method of preventing or treating atherosclerosis or restenosis using a compound of formula (III), classified in class 514, subclass 312.
- IV. Claims 31-32, drawn to a method of preventing or treating atherosclerosis or restenosis using a compound of formula (IV), classified in class 514, subclass 291.
- V. Claims 33-41, drawn to a method of preventing or treating atherosclerosis or restenosis using a compound of formula (V), classified in class 514, subclass 291.
- VI. Claims 42-53, drawn to a method of preventing or treating atherosclerosis or restenosis using a compound of formula (VI), classified in class 514, subclass 312.

Claims 1 and 54-58 link Inventions I through VI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1 and 54-58. Upon the allowance of the linking claim(s), the restriction requirement as to the linked

inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP §804.01.

The inventions are distinct, each from the other, for the following reasons:

Inventions I through VI are patentably distinct. Inventions are patentably distinct if it can be shown that they have different modes of operation, different functions, or different effects and different resultant endpoints (See MPEP §806.04, MPEP §808.01). In the instant case, the inventive methods of Group I through VI are considered distinct because the process steps involved in each invention are unique to the method and are distinctly different from the process steps of the other method or methods, such that a search in the patent or non-patent literature for one of the methods would not result in a complete or comprehensive search of any one or more of the other methods. Notwithstanding that Applicant may have discovered an underlying commonality between compounds of formulas (I), (II), (III), (IV), (V) or (VI), in that each has efficacy in preventing or treating atherosclerosis or restenosis, it remains that a search in the patent or non-patent literature for any one of compounds of formula (I), (II), (III), (IV), (V) or (VI) for the treatment of such a disorder would not necessarily result in a comprehensive search

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for any one or more of the other compounds. Despite the fact that there may be incidental overlap between any one or more of the compounds, such does not change the fact that each of the compounds of formulas (I), (II), (III), (IV), (V) or (VI) are patentably distinct from one another because the art does not recognize each of the formulas as sharing a common physical structure or function. In addition, discovery of any one of compounds of formulas (I), (II), (III), (IV), (V) or (VI) would not anticipate or reasonably suggest or render obvious any one or more of other compounds of the other formulas. For these reasons, the methods of Groups I through VI are considered patentably distinct from one another.

Claims 1-10, 12, 16, 19, 22-31, 33-36, 42-50 and 52-53 are generic to a plurality of disclosed patentably distinct species comprising compounds of formulas (I), (II), (III), (IV), (V) or (VI). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should Applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A proper reply to this Office Action will include: (i) an election of a species of a compound of formula (I), (II), (III), (IV), (V) or (VI) depending upon the invention elected (either one of Groups I-VI, respectively); (ii) a structural depiction of the elected species; (iii) a chemical name of the elected species; (iv) identification of each of the claims readable upon the elected species; and (v) identification of each of the specific moieties present in the elected

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species and the specific chemical group chosen to define each of the moieties present in the elected species.

A telephone call was made to Sidney B. Williams at Flynn, Thiel, Boutell & Tanis, P.C. on Monday, November 28, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

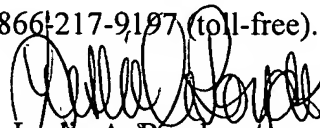
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (8:30 AM-6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie A. Royds  
Patent Examiner  
Art Unit 1614

November 28, 2005



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